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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,164	07/02/2001	Eric C. Haseltine	530057-319	2603
46560	7590	09/11/2006	EXAMINER	
THE WALT DISNEY COMPANY C/O GREENBERG TRAURIG LLP 2450 COLORADO AVENUE SUITE 400E SANTA MONICA, CA 90404			CHAMPAGNE, DONALD	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/898,164	HASELTINE ET AL.	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 15 June 2006.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-13,38-46 and 51 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-13,38-46 and 51 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 02 July 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

Election/Restriction

1. Applicant's election of group 1, comprising claims 1-13, 38-46 and 51, in the reply filed on 15 June 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 51 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At the fourth line from the end, "the information in the database" is indefinite. The claim is limited to "entering consumer information into a database" (lines 4 and 5) and "entering the token information into a database" (lines 4 and 5 from the end). It is not clear which information and which database id being referred to at the fourth line from the end.

Claim Rejections - 35 USC § 102 and 35 USC § 103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-6, 8-13, 38, 39, 41, 42, 44, 46 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by James (US005500681A).
7. James teaches (independent claims 1, 38, 46 and 51) a method and system to receive information/advertising and for marketing to consumers, the method comprising:
 - providing a programming broadcast signal, a token with the programming broadcast signal, and an incentive (*a product coupon*) for using the token capture device to receive the token (col.1 line 66 to col. 2 line 3); and
 - providing a token capture device (TCD) configured to receive the token during the providing of the programming broadcast signal (col. 2 lines 11-15, col. 2 lines 42-52 and col. 3 lines 31-37, where the combination of *a passive magnetic card or a "smart card"* and *subscriber unit 20* reads on a token capture device).

For claim 51, cable television is interpreted as broadcast television (para. 8-9 below). James teaches a cable television *subscriber*, which reads on providing a registration venue at the consumer's home, gathering consumer information at said venue and entering the information in a database. Anyplace that the consumer delivers the TCD/*passive magnetic card/smart card* for coupon redemption is a receiving venue. James also teaches targeting promotional based, at least in part, on the information in the database (the information in the *256-bit demographic information field*), which reads on preparing promotional based, at least in part, on the information in the database.

8. Note on interpretation of claim terms Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.

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9. The instant application contains no such clear definition for the terms "broadcast signal" (claim 1 line 3) and "a television broadcast" (claims 4 and 42). The examiner is required to give these terms their broadest reasonable interpretation. The examiner interprets "broadcast signal" to be any electronic broadcast medium. That is essentially the definition suggested by the instant application (para. [0016]).
10. The examiner interprets "a television broadcast" to be any broadcast for television, including those broadcasts delivered by cable. That is consistent with the definition of "broadcast" in Merriam-Webster's Collegiate Dictionary (10th ed.). James discloses *irradiative* broadcast (col. 10 lines 8-12). That narrower definition is not available to applicant because it is not disclosed in the instant application as filed. Second, it is common for cable networks to deliver at least some signals that were broadcast irradiatively, so the narrower definition would not overcome the instant rejection.
11. Jones also teaches at the citations given above claims 2-6, 10-13, 39, 41 and 42. Jones also teaches claims 8, 9 and 44 (col. 2 lines 62-65).
12. Claims 7, 40, 43 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over James (US005500681A).
13. James does not teach an infrared token (claim 7). Because James does teach dissemination by virtually all broadcast media (col. 2 lines 62-65), and therefore all parts of the electromagnetic spectrum, infrared broadcast would have been obvious to one of ordinary skill in the art, at the time of the invention. James does not teach exchange of the TCD (claim 40). Simple wear and desire to upgrade the TCD/*passive magnetic card/smart card* taught by James would make replacement obvious. James does not teach (claims 43 and 45) that the broadcast signal comprises motion picture film or computer software. The former is obvious because movies are frequently broadcast on TV. The latter is obvious because it is encompassed by the interpretation of broadcast signal", which is also the interpretation disclosed by applicant (para. 9 above).

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 8:30 AM to 7 PM ET, Monday to Thursday. The

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examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

15. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.
16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
17. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

4 September 2006

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622